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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,697	10/17/2005	Matthias Braun	BRAUN-9	2000

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350 FIFTH AVENUE
SUITE 4714
NEW YORK, NY 10118

EXAMINER

SOHN, SEUNG C

ART UNIT	PAPER NUMBER
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2878

MAIL DATE	DELIVERY MODE
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01/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553,697

Applicant(s)

BRAUN ET AL.

Examiner

SEUNG C. SOHN

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20051017.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. ***Claim 8 is rejected under 35 U.S.C. 112, second paragraph***, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 8 provides for the use of a ferrofluid seal, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. ***Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mikhalev et al. (Pat. No. US 5,954,342).***

Regarding claims 1 and 8, Mikhalev et al. discloses a bearing; a coding disk; and sealing means for providing a seal between the bearing and the coding disk, said sealing means being constructed in the form of a ferrofluid seal.

Regarding claim 2, Mikhalev et al. discloses that the bearing is constructed to support the sensor without play.

Regarding claim 3, Mikhalev et al. discloses a sensor shaft, and a sensor flange supported by the sensor shaft via the bearing, wherein the ferrofluid seal includes a magnet which is magnetized axially and has opposite end faces, flux guide elements disposed at the end faces, and a ferrofluid liquid, for producing a seal between the sensor flange and the sensor shaft.

Regarding claim 4, Mikhalev et al. discloses a sensor shaft defining an axis; a bearing for support of the sensor shaft; a coding disk disposed on the sensor shaft at a distance to the bearing; and a ferrofluid seal disposed between the bearing and the coding disk to prevent lubricant from migrating from the bearing toward the coding disk.

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Regarding claim 5, Mikhalev et al. discloses that the bearing is constructed to support the sensor shaft without play.

Regarding claim 6, Mikhalev et al. discloses that the ferrofluid seal, includes a magnet which is magnetized in axial direction, a flux guide element disposed at one end face of the magnet, and a ferrofluid ring disposed between the flux guide element and an outer surface of the sensor shaft.

Regarding claim 7, Mikhalev et al. discloses that the ferrofluid seal includes a magnet which is magnetized in axial direction and has opposite end faces, two flux guide elements disposed respectively at the end faces of the magnet, and two ferrofluid rings disposed respectively between the flux guide elements and an outer surface of the sensor shaft.

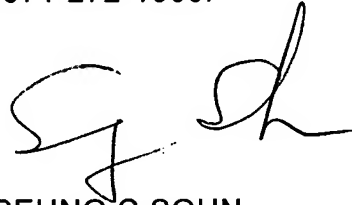
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEUNG C. SOHN whose telephone number is 571-272-4123. The examiner can normally be reached on M-TH, 8 AM -7 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GEORGIA Y. EPPS can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'S. C. Sohn', is positioned above the printed name.

SEUNG C SOHN
Examiner
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